

REMARKS

Claims 1, 4-18, 20, 21, 24-32, 34, 36, and 37 are pending and under current examination. In the Office Action, the Examiner: objected to claim 34 due to an informality at line 3 of the claim; rejected claims 1, 5, 8, 10, 12-18, 20, 21, 26, 28, 29, and 34 under 35 U.S.C. § 102(b) as being anticipated by International Published Application No. WO 97/15009 to Bajpai ("*Bajpai*"); rejected claims 4, 6, 7, 24, 25, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of International Published Application No. WO 01/18625 A1 to Cha et al., ("*Cha*"); rejected claims 9 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent Application No. 5,111,384 to Aslanian et al., ("*Aslanian*"); rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent Application No. 6,877,115 to Herman ("*Herman*"); and rejected claims 30-32 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent Application No. 6,681,344 to Andrew ("*Andrew*").

I. Objection of Claim 34

In the Final Office Action, the Examiner objected to claim 34 because line 3 of the claim refers to claims "23-32" but claim 23 has been cancelled. By the present amendment, Applicant has revised claim 34 to correct this informality in accordance with the Examiner's recommendation. That is, line 3 of amended claim 34 now refers to "24-32" consistent with the claims pending in the present application. In view of this amendment, reconsideration and withdrawal of the objection is respectfully requested and deemed appropriate.

II. Rejection under 35 U.S.C. § 102(b)

Applicant respectfully traverses the rejection of claims 1, 5, 8, 10, 12-18, 20, 21, 26, 28, 29, and 34 under 35 U.S.C. § 102(b) as being anticipated by *Bajpai*. Applicant respectfully disagrees with the Examiner's arguments and conclusions.¹

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131.

Bajpai does not disclose each and every element of Applicant's claimed invention, despite the Examiner's allegations. For example, *Bajpai* does not disclose a "main system [that] has a client/server configuration with a database, an application server, and a front end server", as required by independent claim 1 (emphasis added). *Bajpai* also fails to disclose or teach such a "main system" as similarly defined in independent claim 20 (see the last five lines of that claim).

In the Final Office Action, the Examiner asserts that the claimed "main system" is taught by the local digital data processor 10 of *Bajpai* (see Figure 1). With reference to Figure 2, the Examiner also appears to argue that the claimed "database" is

anticipated by databases 34, 36 and 38, the claimed "front end server" is shown by front end 32, and the claimed "application server" is disclosed by expert system 30.

Applicant respectfully disagrees with the Examiner's assertions.

As noted above, the claimed "main system" is defined as having a "client/server configuration." In contrast, the local digital data processor 10 of *Bajpai* is a stand-alone processor and not capable of operating in a client/server configuration, as claimed. This is clearly shown by Figure 1 of *Bajpai*. Further, at page 4, ll. 20-21, *Bajpai* clearly states that: "[d]igital data processor 10, for example, can be a personal computer or workstation that resides at a user's home or office."

Figure 2 of *Bajpai* does not alter this conclusion. Figure 2 of *Bajpai* shows a local diagnostic element 28 that is resident on the local digital data processor 10. The local diagnostic element contains a front end 32, expert system 30, and databases 34, 36, and 38. However, these components of the local diagnostic element are not provided in a "client/server configuration" as *Bajpai* clearly states that: "[t]he local diagnostic element is, preferably, a software package resident on the digital data processor 10 that executes on that computer", (*Bajpai*, page 5, ll. 3-4, emphasis added). Accordingly, local diagnostic element 28 is simply a software program running on an individual workstation (i.e., local digital data processor 10) and *Bajpai* does not disclose a "main system" in "a client/server configuration" as required by claims 1 and 20.

Bajpai also fails to disclose or anticipate other features of the claimed "main system." For example, the front end 32 and expert system 30 of *Bajpai* do not

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of

constitute a "front end server" and "application server," as claimed. As discussed above, *Bajpai* discloses items 32 and 30 as being components of a software program running on a single workstation. Therefore, these software components do not constitute separate server elements or, more specifically, a "front end server" and "application server" of a main system, as defined by the claims of the present application.

Moreover, *Bajpai* does not disclose or teach an "auxiliary system [that] uses the client/server configuration of the main system," as required by claim 1. Even if one were to assume that the remote diagnostic system 12 of *Bajpai* is some form of an "auxiliary system", it does not use a "client/server configuration" of a main system, as required by claim 1. For the reasons noted above, the local digital data processor 10 of *Bajpai* is not implemented in a client/server configuration. Thus, while the remote diagnostic system 12 can communicate with the local digital data processor 10 (the purported "main system" according to the Examiner), the system 12 does not use a "client/server configuration" since processor 10 is not implemented as one.

Furthermore, *Bajpai* specifically describes the remote system 12 as being implemented as a stand-alone workstation (see page 4, ll. 21-24) and not being reliant upon or using a client/server configuration.

Accordingly, for at least the foregoing reasons, independent claims 1 and 20 are patentable over *Bajpai* and Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 102(b).

whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Dependent claims 5, 8, 10, 12-18, 21, 26, 28, 29, and 34 depend from claim 1 or 20 and, therefore, require all of the noted elements thereof. As set forth above, *Bajpai* fails to teach each and every element of claims 1 and 20. Therefore, for similar reasons, claims 5, 8, 10, 12-18, 21, 26, 28, 29, and 34 are also patentable over the prior art and the rejection under 35 U.S.C. § 102(b) based on *Bajpai* should be withdrawn.

III. Rejection under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of claims 4, 6, 7, 9, 11, 24, 25, 27, 30-32, 36, and 37 under 35 U.S.C. § 103(a), because no *prima facie* case of obviousness has been established. As M.P.E.P. § 2142 states, “[t]he Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006), p. 2100-125, 126.

Each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143.

Here, no *prima facie* case of obviousness has been established for at least the reason that the cited references fail to teach or suggest each and every element of

independent claims 1 and 20, from which the rejected claims depend. This is because *Cha*, *Aslanian*, *Herman*, and *Andrew* fail to cure the noted deficiencies of *Bajpai*. That is, *Cha*, *Aslanian*, *Herman*, and *Andrew*, fail to disclose or suggest a “main system” in a “client/server configuration” and that includes “a database, an application server, and a front end server.” Moreover, the cited references fail to teach or suggest an “auxiliary system [that] uses the client/server configuration of the main system.” Accordingly, *Bajpai*, *Cha*, *Aslanian*, *Herman*, and *Andrew*, when taken alone or in any proper combination, fail to establish a *prima facie* case obviousness with respect to claims 1 and 20 and, in view of their dependency, claims 4, 6, 7, 9, 11, 24, 25, 27, 30-32, 36, and 37. As such, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a).

CONCLUSION

For at least the foregoing reasons, Applicant submits that the claims are neither anticipated nor rendered obvious by *Bajpai* or the other references cited against this application. Applicant, therefore, requests the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, consisting of a large, stylized 'G' followed by a horizontal line extending to the right.

Dated: December 1, 2006

By: _____

C. Gregory Gramenopoulos
Reg. No. 36,532